

Claims 1, 2, 3 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nonaka (U.S. Patent 4,689,966) in view of Burkhalter (German Patent Document 2700928). Applicants respectively traverse this rejection.

In the Office Action under reply, the Examiner asserted that Nonaka discloses a damper arranged in a passage in a refrigerator through which cold air flows and includes a frame, a cold air gate, a baffle, and a rotation mechanism, as recited in claim 1 of the present application. Nonaka, however, does not disclose that the rotation mechanism includes a motor that is arranged outside the frame and in the vicinity of the rotation shaft of the baffle, an output shaft of the motor that is rotatably secured to the rotation shaft of the baffle, and the output shaft of the motor is attached to the rotation shaft of the baffle via a decelerating gear. To cure these deficiencies, the Examiner relied upon Burkhalter for teaching a rotation mechanism that includes a motor, an output shaft, and a decelerating gear.

The Nonaka patent concerns a refrigerator that has a mode-change chamber that is capable of operation within a freezing temperature range, a chill temperature range and a refrigeration temperature range. As shown in Fig. 4 of Nonaka and as discussed at col. 3, lines 50-68, damper 70 includes a damper plate 71 with which operating lever 79 is integrally formed, and damper plate 71 is manually pivoted when the top of operating lever 79 is moved in a direction against the biasing force of a tension spring 73.

Burkhalter concerns an electric motor retainer restrictor for a valve operation. Fig. 2 of Burkhalter discloses motor 16 with various gears attached thereto and a rotation shaft 12. It is submitted that one who reads and understands Burkhalter would be neither encouraged nor motivated to use Burkhalter's gear/motor apparatus within the refrigeration unit disclosed in

Nonaka. Nonaka neither discloses nor suggests opening/closing a damper via a motor. On the flip side, Burkhalter neither discloses nor suggests utilizing its electric motor rotation restrictor for the purpose of opening/closing a damper within a refrigerator. Thus, if the Nonaka patent does not lead one of ordinary skill in the art to utilize a motor for opening and closing a damper, and if Burkhalter does not lead one of ordinary skill in the art to include the disclosed motor rotation restrictor within a refrigerator for the purpose of opening/closing a damper, then why would it be obvious to combine these two references? If it is submitted that, in the absence of any suggestion, direction or motivation in either of these references, it is not proper to combine them to reject claim 1. See In re Laskowski, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989).

It is further submitted that there is no objective teaching in the cited prior art that would lead one to combine the teachings of Yamanaka with the teaching of the prior art discussed in this application as proposed by the Examiner. Without such objective teaching, it is erroneous to reject claim 1. In re Fritch, 23 U.S.P.Q. 2d, 1780, 1783 (Fed. Cir. 1992); In re Bond, 15 U.S.P.Q. 2d, 1566, 1568 (Fed. Cir. 1990); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

The decision of In re Geiger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987) is quite relevant. There, the Federal Circuit stated:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination."

* * *

"At best, in view of these [prior art] disclosures, one skilled in the art might find it obvious to try various combinations of these

known [agents]. However, this is not the standard of 35 U.S.C. §103."

The Federal Circuit has been consistent in warning against hindsight reconstruction of the prior art. As pointed out in Uniroyal v. Rudkin-Wiley, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988);

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination."

* * *

"... it is impermissible to use the claims as a frame in the prior art references as a mosaic to piece together a facsimile of the claimed invention."

Even though the combination of references may suggest the claimed invention, there still must be some teaching or suggestion in at least one of those references or in the prior art as a whole, that would lead one with ordinary skill in the art to make the combination. Id. at 1439.

In combining Nonaka with Burkhalter, the Examiner asserted that "[I]t would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Nonaka by using a motor as taught by Burkhalter for the purpose of having a motorized means for operating a baffle." If appears, then, that the Examiner concludes that since a damper in Nonaka includes a rotation shaft, and since Burkhalter discloses a motorized means for operating a rotation shaft, it would be "obvious" to replace the operating lever 79 of Nonaka (for manual

operation of the damper) with the electric motor rotation restrictor disclosed in Burkhalter. It is submitted that this attempted substitution is not proper and it can not be said that rotation is rotation, without regard to what is being rotated. In the Uniroyal case, the CAFC referred to Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Company, 221 U.S.P.Q. at 489, to conclude that "the mere fact that a device or process utilizes a known scientific principle does not alone make that device or process obvious." 5 U.S.P.Q. 2d at 1440.

In Orthopaedic Equipment Company, Inc. v. United States, 217 U.S.P.Q. 193-199 (Fed. Cir. 1983), the Federal Circuit warned,

"The difficulty which attaches to all honest attempts to answer this question [of obviousness based upon a combination of prior art] can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of unobviousness in a court of law."

In reversing an Examiner's rejection based upon obviousness, wherein the Examiner concluded that a claimed apparatus is shown simply by turning a prior art reference "upside down", the CAFC ruled:

"the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), and citations noted therein.

In view of the foregoing analysis and authorities, it is respectfully submitted that the combination of Nonaka and Burkhalter for the purpose of rejecting claim 1 is not proper. Claim

1 is patentably distinct and unobvious over this prior art. It is requested that the rejection of claim 1 be withdrawn.

Since claims 2, 3 and 6 depend from claim 1, the foregoing discussion of claim 1 is equally applicable to claims 2, 3 and 6 and is believed to obviate the rejection of claims 2, 3 and 6.

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nonaka in view of Burkhalter and further in view of Swain, et al. (U.S. Patent 4,527,734). Claims 5, 9, 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nonaka in view of Burkhalter and further in view of Hood, et al. (U.S. Patent 4,957,274). Claim 9 is amended herein to be placed in independent form and to include all of the limitations recited in claim 1. Since claim 5 depends from claim 1, claim 9 includes all of the limitations recited in claim 1, and claims 10 and 11 depend from claim 9, the foregoing discussion of claim 1 is equally applicable to claims 5, 9, 10 and 11 and believed to obviate the rejection of claims 5, 9, 10 and 11.

Moreover, it is submitted that it would not have been obvious to one of ordinary skill in the art to combine Hood, et al. with Nonaka basically for those reasons previously discussed in the discussion regarding Nonaka and Burkhalter. It is requested that the rejection of claim 9 be withdrawn.

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nonaka in view of Burkhalter and further in view of Mingrone, et al. (U.S. Patent 3,288,370). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nonaka in view of Burkhalter and further in view of Breen (U.S. Patent 3,108,452). For those reasons previously discussed, and since neither Mingrone, et al nor Breen discloses or suggests the aforementioned deficiencies of

Nonaka, it is submitted that claims 7 and 8 are patentable over the combination of Nonaka, Burkhalter, Mingrone, et al. and/or Breen.

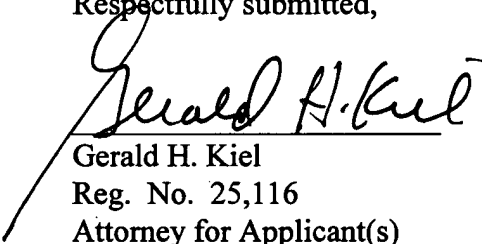
Claims 12 and 13 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants appreciate the Examiners finding that claims 12 and 13 recite patentable subject matter. Claim 12 is written herein to be placed in independent form and to include all of the limitations of claims 1 and 9. It is requested that the objection to claim 12, and the objection to claim 13 since it depends from claim 12, be withdrawn.

On the basis of the above amendments and remarks, reconsideration and allowance of this application are respectfully requested.

Should the Examiner believe that direct contact with Applicants' attorney would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

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